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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,114	07/07/2003	Richard Levy	01064.0011-08-000	7674

7590 03/23/2005

THE LAW OFFICES OF ROBERT J. EICHELBURG
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EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,114

Applicant(s)

LEVY, RICHARD

Examiner

Jill M. Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-63,65-71,73,76 and 87-90 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 57-63,65-71,73,76 and 87-90 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/7/03, 4/7/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: the present status (whether patented or abandoned) of the parent application must be indicated.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 62-63 and 70-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the language "substrate comprises a cable" (claims 62 and 70) and "substrate comprises a wire" (claims 63 and 71) lacks support from the originally filed specification. There is no disclosure of the present invention whereby the substrate is a cable or a wire.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57-63, 65-71, 73, 76, and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman 5,218,011 in view of Marciano-Agostinelli et al, 5,049,593 (Marciano-Agostinelli).

Freeman teaches an essentially water-free gel composition and method for protecting a substrate such as wires and able from damage by water, said gel composition comprising a gel matrix, thickener and water absorbent polymer dispersed therein, wherein the gel matrix can be silicones, petroleum gels, high viscosity esters (fatty oils), glycols, olefins, mineral oil and fluorocarbons, as required by claims 57-58, 61-63, 65-66, 69-71, and 89-90. See abstract and column 7, lines 19-39 and line 58 through column 8 and line 9. In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates and acrylic acid, as required by claims 59-60 and 67-68. See column 6, lines 20-29. As to claims 87 and 88, it should be noted that these claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Freeman is silent as to the amount of absorption of the superabsorbent particles as well as particle size.

Marciano-Agostinelli teaches a water migration resisting filler comprising a polymeric compound and particles of a water swellable material that is applied to stranded wires of cable, said particles having a particle size of less than 200 microns,

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per claims 73 and 76. See abstract and column 5, lines 51-53. The particles are of the type contemplated by applicants in claims 59-60 and 67-68, such as acrylamide and acrylate and have a water absorbing capability of 100 times its weight in water, as required by applicants in claims 57 and 65. See column 5, lines 43-62.

Though Freeman is silent as to the specific particle size of his particles, it is the examiner's position that changes in size are ordinarily not a matter of invention and that where the difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In the instant case, the present claimed composition having superabsorbent particles of the requisite particle size would not perform differently than the prior art composition. In the alternative, Marciano-Agostinelli teaches the usage of superabsorbent particles having a particle size within the range contemplated by applicants. It would have been obvious to the skilled artisan at the time the invention was made to modify the teachings of Freeman by using superabsorbent particles having a particle size of within applicant's claimed range, as taught by Marciano-Agostinelli, motivated by a reasonable expectation of success of obtaining a water migration resisting composition that can be applied to wire and cable and provide effective water blocking capabilities. As to the specific water absorbing properties of the superabsorbent particles, Marciano-Agostinelli teaches particles of the same type contemplated by applicant and as taught by Freeman. The skilled artisan

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would reasonably presume that the same particles necessarily have the same properties in the absence of factual evidence to the contrary.

Therefore, the combined teachings of Freeman and Marciano-Agostinelli would have rendered obvious the invention as claimed in the present claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-63, 65-71, 73, 76, and 87-90 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 82-97 and 100-102 of copending Application No. 09/779,559. Although the conflicting claims are not identical, they are not patentably distinct from each other because the silicones of the copending application are "synthetic lubricants" as required by the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

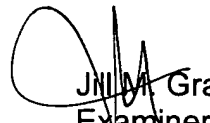
No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill M. Gray
Examiner
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jmg